

REMARKS/ARGUMENTS

Claims 7-11, 15-22, and 24-26 are pending in this application. By this Amendment, Applicant amends Claims 7, 8, 15, and 17-19 and cancels Claims 12-14 and 23.

Applicant's counsel appreciates the courtesies extended by the Examiner in the interview of May 2, 2008. In the interview, Applicant's counsel and the Examiner discussed the differences between the applied prior art (Endo et al. (U.S. 5,487,441) and Smolka et al. (U.S. 3,797,844)) and the present invention, the rejection under 35 U.S.C. § 112, first paragraph, and possible amendments to independent claims 7 and 17 which would overcome the prior art rejections.

The Examiner is reminded that in an Information Disclosure Statement filed on December 7, 2006, Applicant cited copending U.S. Patent Application No. 10/538,987 to bring to the attention of the Examiner and have the Examiner consider the subject matter and claims of the copending U.S. Patent Application(s), the prior art references, Office Actions and responses to Office Actions made of record in the copending U.S. Patent Application(s). The Examiner is respectfully requested to update his/her review and consideration of the claims of the copending U.S. Patent Application(s), the prior art references, Office Actions and responses to Office Actions made of record in the copending U.S. Patent Application(s).

The drawings were objected to for allegedly failing to show every feature of the invention specified in the claims. Particularly, the Examiner alleged that "the case with a fixing element arranged to fix a central region of the case to the board, leaving front and rear ends of the case free, where the case is slidably attached to the board (claim 13) must be shown or the feature(s) canceled from the claim(s)." Claim 13 has been canceled. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this objection.

Claims 7-26 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Particularly, the Examiner

alleged that the specification as filed and the drawings fail to completely support the recitation of a motor controller arranged to supply at least one wheel with rotary power. Applicant respectfully disagrees.

As discussed in the interview of May 2, 2008, Fig. 7 of the originally filed drawings schematically shows the electrical connections between drive motor 15 and the controller 9. The particular structural connection between the drive motor 15 and the controller 9 would have been readily apparent to one of ordinary skill in the art, i.e., by routing wires from the controller 9 on the board to the drive motor 15 in the drive wheel 7, as shown in Fig. 4. Claims 7 and 17 merely broadly recite the feature of "a motor controller arranged to supply at least one of the wheels with rotary power." Applicant respectfully submits that Figs. 4 and 7 of the originally filed drawings, and the accompanying description thereof provided in paragraphs [0038]-[0040] and [0044]-[0047] of the originally filed specification, comply with the written description requirement and provide support for the recitation of the feature of "a motor controller arranged to supply at least one of the wheels with rotary power."

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 7-26 under 35 U.S.C. § 112, first paragraph.

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Applicant has amended Claim 8 to correct the informality noted by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 8 under 35 U.S.C. § 112, second paragraph.

Claims 7-12, 14, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. Claims 13 and 17-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. in view of Smolka et al. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. in view of Staelin et al. (U.S. 6,059,062). Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. in view of Smolka et al., and further in view of Staelin et al. Claims 12-14 and 23 have been canceled. Applicant respectfully

traverses the rejections of Claims 7-11, 15-22, and 24-26.

Claim 7 has been amended to recite:

A skateboard comprising:  
a board;  
wheels provided on a bottom surface of the board, at front and rear regions thereof;  
a motor controller arranged to supply at least one of the wheels with rotary power;  
a case provided on the bottom surface of the board and housing the motor controller, the case including side edge surfaces, a top plate extending between the side edge surfaces, and a bottom plate spaced from the top plate and extending between the side edge surfaces; and  
**at least one fixing element arranged to fix a substantially central region of the case to the board so as to leave front and rear end regions of the case free;** wherein  
**the top plate of the case is arranged to be in contact with the bottom surface of the board; and**  
**the at least one fixing element is spaced inwardly from the side edge surfaces of the case and connects the top plate of the case to the board.** (emphasis added)

With the unique combination and arrangement of features recited in Applicant's Claim 7, including the features of "at least one fixing element arranged to fix a substantially central region of the case to the board so as to leave front and rear end regions of the case free," "the top plate of the case is arranged to be in contact with the bottom surface of the board," and "the at least one fixing element is spaced inwardly from the side edge surfaces of the case and connects the top plate of the case to the board," Applicant has been able to provide a skateboard that provides a natural ride and good operability without adversely influencing a drive power controller such as a controller and a battery (see, for example, paragraph [0006] of the originally filed specification).

The Examiner alleged that Endo et al. teaches all of the features recited in Applicant's Claim 7, except for the feature of a case for the controller which comprises a battery. However, the Examiner alleged, "It is very old and well known to provide

controllers and/or batteries in casings so as to protect them from damage.” Thus, the Examiner concluded that it would have been obvious “to provide a case to accommodate the battery for the very well known purpose of preventing damage to the battery.”

Applicant's Claim 7 has been amended to recite the features of “at least one fixing element arranged to fix a substantially central region of the case to the board so as to leave front and rear end regions of the case free,” “the top plate of the case is arranged to be in contact with the bottom surface of the board,” and “the at least one fixing element is spaced inwardly from the side edge surfaces of the case and connects the top plate of the case to the board.” Support for these features is found, for example, in paragraphs [0041] and [0042] and Figs. 1 and 5 of the originally filed application.

As discussed in the interview of May 2, 2008 and acknowledged by the Examiner, Endo et al. fails to teach or suggest any case or any fixing elements which fix a case to a board. Thus, Endo et al. clearly fails to teach or suggest a case having a top plate, and certainly fails to teach or suggest the features of “at least one fixing element arranged to fix a substantially central region of the case to the board so as to leave front and rear end regions of the case free,” “the top plate of the case is arranged to be in contact with the bottom surface of the board,” and “the at least one fixing element is spaced inwardly from the side edge surfaces of the case and connects the top plate of the case to the board” as recited in Applicant's Claim 7.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Endo et al.

Applicant's Claim 17 has been amended to recite:

A skateboard comprising:  
a board;  
wheels provided on a bottom surface of the board, at front and rear regions thereof;

a motor controller arranged to supply at least one of the wheels with rotary power;  
a case provided on the bottom surface of the board and housing the motor controller; and  
**a plurality of supports arranged to support both longitudinal ends of the case on the bottom surface of the board; wherein each of the plurality of supports and the case are arranged to move relative to one another in a longitudinal direction along the board at least when a load is applied on the board.** (emphasis added)

The Examiner alleged that Endo et al. teaches all of the features recited in Applicant's Claim 17, except for "the battery and/or case as being slidably attached to the board, so as to allow longitudinal movement of the casing." The Examiner further alleged that Smolka et al. teaches this feature. Thus, the Examiner concluded that it would have been obvious "to provide the battery mounting as a mount having a guide rail and amounting pins and/or elongated openings, as taught by Smolka [et al.] to mount the battery taught by Endo et al. to the bottom of the board of Endo et al., for the purpose of allowing the flexibility of Endo et al.'s board to be unimpeded by the presence of the battery and casing."

Applicant's Claim 17 has been amended to recite the features of "a plurality of supports arranged to support both longitudinal ends of the case on the bottom surface of the board" and "each of the plurality of supports and the case are arranged to move relative to one another in a longitudinal direction along the board at least when a load is applied on the board." Support for these features is found, for example, in paragraphs [0050]-[0059] and Figs. 10(a) to 15(b) of the originally filed application.

As discussed in the interview of May 2, 2008, in each embodiment taught by Smolka et al., one end of the binding 1 is fixed by a pin 8 disposed in a hole and the other end is slidable due to a pin 7 being disposed in an elongated slot 10. Thus, at best, Smolka et al. teaches a binding in which only one end of the binding 1 moves longitudinally along the ski. Smolka et al. certainly fails to teach or suggest the features of "a plurality of supports arranged to support both longitudinal ends of the case on the

bottom surface of the board" and "each of the plurality of supports and the case are arranged to move relative to one another in a longitudinal direction along the board at least when a load is applied on the board" as recited in Applicant's Claim 17

Furthermore, the location of one end of the binding 1 of Smolka et al. must necessarily be fixed in order for the binding to be suitable for its intended use. If the binding 1 of Smolka et al. was modified such that both ends of the binding 1 were slidable longitudinally along the ski 5, the resulting ski and binding would be unsuitable for its intended use because the binding 1 and attached ski boot would be slidable in a longitudinal direction of the ski 5, which would drastically reduce the control a skier would have over the skis. Thus, it would not have been obvious to modify the binding 1 of Smolka et al. such that both ends of the binding 1 are slidable longitudinally along the ski 5.

The Examiner is reminded that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP § 2143.01.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Endo et al. in view of Smolka et al.

The Examiner relied upon Staelin et al. to allegedly cure deficiencies of Endo et al. and Smolka et al. However, Staelin et al. fails to teach or suggest the features of "at least one fixing element arranged to fix a substantially central region of the case to the board so as to leave front and rear end regions of the case free," "the top plate of the case is arranged to be in contact with the bottom surface of the board," and "the at least one fixing element is spaced inwardly from the side edge surfaces of the case and connects the top plate of the case to the board" as recited in Applicant's Claim 7, and the features of "a plurality of supports arranged to support both longitudinal ends of the case on the bottom surface of the board" and "each of the plurality of supports and the

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case are arranged to move relative to one another in a longitudinal direction along the board at least when a load is applied on the board" as recited in Applicant's Claim 17.

Accordingly, Applicant respectfully submits that Endo et al., Smolka et al., and Staelin et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of features recited in Applicant's Claims 7 and 17.

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 7 and 17 are allowable. Claims 8-11, 15, 16, 18-22, and 24-26 depend upon Claims 7 and 17, and are therefore allowable for at least the reasons that Claims 7 and 17 are allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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